

REMARKS

I. Introduction

Claims 7 and 9 to 12 are pending in the present application after the cancellation, without prejudice, of claim 8. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority. As regards the priority document, the Office Action Summary indicates that "some" certified copies of the priority document were received. The present application claims priority to a single application, namely, German Application No. 102 56 662.3. The USPTO PAIR system indicates that the Office has received a copy of the priority document. A copy of the priority document has been printed from the PAIR system and is attached hereto. Applicants respectfully request clarification as to the Office's receipt of the priority document with the next Office communication.

II. Information Disclosure Statement

As regards the Information Disclosure Statement, the Office Action includes a signed copy of the PTO-1449 paper indicating that all references cited therein had been considered. While Applicants respectfully submit that the Information Disclosure Statement fully complies with the requirements of 37 C.F.R. § 1.98, to facilitate matters, submitted herewith is a Supplemental Information Disclosure Statement again citing the same documents previously cited and providing copies of the same.

III. Rejection of Claims 7 to 12 Under 35 U.S.C. § 103(a)

Claims 7 to 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,245,789 ("Gray"). It is respectfully submitted that Gray does not render unpatentable the present claims as amended herein for at least the following reasons.

As an initial matter, claim 8 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 8.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but

the prior art must also suggest combining the elements in the manner contemplated by the claim. See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990), *cert. denied* 111 S.Ct. 296 (1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

Claim 7 relates to a fuel injector for a fuel injection system that includes, *inter alia*, at least one of an armature stop face and a stop face having a coating, the coating having a surface structure having raised areas and recessed areas, wherein the raised areas have a dome-shaped design. Gray does not disclose, or even suggest, at least the feature of a coating having a surface structure having raised areas and recessed areas, wherein the raised areas have a dome-shaped design.

Gray relates to an electromagnetic fuel injector. In order to increase the true contact area between the surfaces of a pole piece and an armature, Gray describes providing opposed working air gap surfaces of the pole piece and the armature with an average surface roughness rating value on the order of 16 to 32 microinches. As shown in Figure 4, the roughened surface has peaks and valleys extending from opposite sides of the center line. See *also* column 8, lines 63 to 68. Thus, Gray does not include at least the feature of a coating having a surface structure having raised areas and recessed areas, wherein the raised areas have a dome-shaped design. This is further indicated by the fact that the roughness of the surfaces described in Gray are obtained by grinding the surface. Column 9, lines 16 to 35. Grinding could not provide a surface having raised areas having a dome-shaped design as recited in amended claim 7. Furthermore, Gray describes taking material away from a surface by grinding, whereas claim 7 recites at least one of the armature stop face and the stop face having a coating, the coating having a surface structure having raised areas and recessed areas. For at least the foregoing reasons Gray does not render unpatentable claim 7.

As for claims 9 to 12, which ultimately depend from claim 7 and therefore include all of the features recited in claim 7, it is respectfully submitted that Gray does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Conclusion

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

KENYON & KENYON LLP

Dated:

October 13, 2006

By:

Gerard A. Messina
Gerard A. Messina
(Reg. No. 35,952)
R.N.
42,194

One Broadway
New York, NY 10004
Telephone: (212) 425-7200
Facsimile: (212) 425-5288
CUSTOMER NO. 26646